5

FILED
AUG 22 1952
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM, 1952

NO. 288

CHAME D. SKINNER and LEO C. BRADLEY,
Petitioners,

v.

THE DOW CHEMICAL COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT OF PETITION.

CHRISTY, PARMELEE & STRICKLAND,
WILLIAM H. PARMELEE,
1621 Farmers Bank Building,
Pittsburgh 22, Pennsylvania.
F. NORMAN HIGGS,
420 Bay City Bank Building,
Bay City, Michigan,
Counsel for Petitioners.

LEO T. WOLFORD,
501 S. Second St.,
Louisville, Kentucky.
FRANCIS R. HARBISON,
1017 Park Building,
Pittsburgh 22, Pennsylvania,
Of Counsel.

SMITH BROS. CO. INC., LAW PRINTERS, 434-438 BLVD. OF ALLIES, PITTSBURGH 19, PA.

TABLE OF CONTENTS.

	PAGE
Petition for Writ of Certiorari	1
Summary and Short Statement of Matter Involved	1
Jurisdiction	5
Questions Raised by the Case	6
Reasons Relied Upon for Allowance of the Writ	6
Brief in Support of Petition	8
Explanation of the Patent and Defendant's Dies	8
The District Court's Findings	10
The Circuit Court of Appeals Found Nothing Clearly Erroneous in the District Court's Findings	12
The Circuit Court of Appeals Is Contrary to the Applicable Decisions of This Court	13
The Decision of the Sixth Circuit Court of Appeals Appears to Be in Conflict With the Applicable Decisions of Other Circuits	16
Conclusion	20

TABLE OF CASES.

Claude Neon Lights, Inc. v. E. Machlett & Son et al., (C.C.A. 2 1929) 36 F. 2d 574	16
Freeman v. Altvater, 66 F. 2d 506	18
Frick Co. v. Lindsay, (C.C.A. 4 1928) 27 F. 2d 59	17
Graver Tank & Manufacturing Co., Inc., et al. v. Linde Air Products Co., 339 U.S. 605	5, 6, 13, 15

of invalidity of the patent, non-infringement and laches were set up. All issues were decided in favor of your Petitioners (R. 519), after which the District Judge, Judge Picard, granted Defendant's Motion to Reopen (R. 537) to receive further evidence in regard to the prior art patents to Hanson, which patents were granted almost one hundred years before the date of Skinner's invention. After hearing additional evidence, the Trial Court again decided for Petitioners (R. 538), stating in effect that he was more sure than ever of the correctness of his first decision.

On the defense of non-infringement, the District Court found as a matter of fact that although specifically different from the structure shown in the patent in suit, the Respondent's dies infringed the Skinner patent. After discussing the evidence the District Court said (R. 524):

> "Taking element for element, although the appearance of the structure is different, parts of the Dow dies are as defined in the Skinner die. Both Dow dies operate the same as the Skinner die to produce the same result and differ from Hanson in the same way that Skinner differs. * * * We find that the Dow dies are only immaterial variants of Skinner, and that there has been an infringement."

The Respondent appealed to the Sixth Circuit Court of Appeals, which reversed the District Court on the finding of equivalence, stating (R. 557):

> "Where the claims of a patent define an element in terms of form, location or function, thereby creating an express limitation, and where that limita-

> tion pertains to an inventive step, other forms may not be treated as an equivalent."

The application of the foregoing rule, which is peculiar to the Sixth Circuit, arbitrarily precludes the Trial Court, confronted with a patent claim so limited, from making any finding of equivalency, or where, as here, findings are made, the application of the rule sets aside such findings automatically and by prejudgment. The application of this rule gives rise to this Petition.

The Sixth Circuit Court of Appeals almost at the beginning of its opinion recognized Skinner's contribution to the art. It said (R. 552):

> "The problem of securing hollow tubes with minimum variation in wall thickness had not been solved in 1930 when Skinner filed his application."

It recognized the value of his contribution, but denied him any reward.

Briefly the history of the invention is that Skinner, an unschooled and non-technical employee of the Aluminum Company of America, conceived his invention, made successful experimental demonstrations to that company, but was unable to conclude any negotiation with the company (R. 520). Thereupon he, with Mr. Bradley and one or two others, organized their own small company. Robertshaw Thermostat Company, a subsidiary of Reynolds Metals Company, took over this small business and bought the patent on a conditional purchase agreement, requiring payment in the nature of a production royalty. Subsequently Reynolds took over Robertshaw's interest, and with the aid of Skinner and Bradley, carried on large operations at Louisville, Kentucky.

Soon there arose a dispute about royalty payments. Litigation followed, which terminated in favor of Skinner and Bradley in the Sixth Circuit Court of Appeals (166 F. (2d) 66; Certiorari denied 334 U.S. 858). In the latter part of December, 1948, in settlement of the litigation, Reynolds took a paid-up license, and title to the patent was transferred to Skinner and Bradley. Having regained title to the patent, the instant suit was filed in 1949 against Respondent, and suits were also filed against several others who, during the period of the Reynolds ownership and litigation, either entered the field or continued with operations begun after the issuance of Skinner's patent. Suits were filed against Bohn Aluminum and Brass Company in Detroit; the instant Respondent; and B. & T. Metals Company, all in the Sixth Circuit; the Aluminum Company of America, in which the District Court has sustained the defense of laches, and from whose decision an appeal has been taken; Revere Copper & Brass, Inc., which suit was settled, and Harvey Machine Company in the Los Angeles area.

The Circuit Court of Appeals did not pass on the defense of invalidity or laches.

Two aspects of the case support the instant Petition and justify action on the part of this Court:

1. A decision by this Court would establish a precedent to be followed in the other suits filed by Petitioners. At the present time this decision confronts Petitioners in two suits in the Sixth Circuit, and has been advanced as a basis for Summary Judgment in one of them.

2. The case is of public importance, in that an arbitrary formula of the Sixth Circuit Court of Appeals is in conflict with Rule 52(a) Federal Rules of Civil Procedure, and the opinion of this Court in *Graver Tank & Manufacturing Co., Inc., et al. v. Linde Air Products Co.*, 339 U.S. 605, and is in apparent conflict with the decisions of other circuits.

Jurisdiction.

1. Jurisdiction is based on the patent laws, particularly Title 28 U.S.C. Section 1338, and Title 35 U.S.C. Section 70.

2. The basis upon which the Court has jurisdiction to review the Final Judgment of Dismissal is Rule 38 of the Supreme Court Rules and the statutes therein referred to, and review on Writ of Certiorari is predicated upon paragraph 5 of Rule 38 for the reason that an important question of Federal law is presented, which should be decided, and there is conflict between the decision of the Circuit Court of Appeals for the Sixth Circuit and the decision of this Court calling for an exercise of this Court's power of supervision.

3. This Petition has been filed within ninety days from the denial of the Petition for Rehearing (*Morse v. U. S.*, 270 U.S. 151, pps. 153, 154; *Gypsy Oil Company v. Leo Bennett Enscoe, et al.*, 275 U.S. 498).

Questions Raised by the Case.

1. Where, in the trial of a patent infringement suit, the District Court makes specific findings establishing equivalence of the alleged infringing structure with the patent, may the Circuit Court, in the absence of any clear showing of error, set aside those findings?

2. By the application of an arbitrary rule or formula, may the Circuit Court of Appeals circumscribe the District Court from making valid findings of infringement based on the doctrine of equivalents or assert such rule to set aside specific findings?

Reasons Relied Upon For Allowance of the Writ.

1. The Court of Appeals has decided this case not in accordance with the applicable decision of this Court as most recently stated in *Graver Tank & Manufacturing Co., et al. v. Linde Air Products,* 339 U.S. 605, and contrary to the provisions of Rule 52(a) Federal Rules of Civil Procedure, and in apparent conflict with the applicable decisions in other circuits.

2. The Court of Appeals has decided an important question of patent law in a way untenable or in conflict with the weight of authority. *Graver Tank & Manufacturing Co., et al. v. Linde Air Products Co.,* 339 U.S. 605.

3. The Court of Appeals has, by the application of an arbitrary rule, so circumscribed the judicial function of the District Judge as a trier of the facts, as to substantially deprive Petitioners of the benefit of all evidence of infringement produced at the trial in their behalf.

Wherefore Petitioners pray that the Writ be granted.

CHRISTY, PARMELEE & STRICKLAND

WILLIAM H. PARMELEE
1621 Farmers Bank Building
Pittsburgh 22, Pennsylvania

F. NORMAN HIGGS
420 Bay City Bank Building
Bay City, Michigan

Counsel for Petitioners

LEO T. WOLFORD
501 S. Second St.
Louisville, Kentucky

FRANCIS R. HARBISON
1017 Park Building
Pittsburgh 22, Pennsylvania

Of Counsel

I, William H. Parmelee, attorney for Petitioners herein, hereby certify that in my judgment the foregoing Petition is well founded, and that the same is not interposed for delay.

WILLIAM H. PARMELEE

BRIEF IN SUPPORT OF PETITION.

The two questions presented herein are so closely related that they will, for purpose of brevity, herein be discussed as one.

Explanation of the Patent and Defendant's Dies.

Attached to, and made a part of the Petition for Rehearing, is a diagram (R. 564-565) having three groups of figures. The first, marked "Skinner", reproduces two figures from the patent drawing. The second, marked "Dow port hole die", are two figures showing similar views of one form of the accused structures, and Figure 3, marked "Dow spider die", shows the other form of accused structure.

Referring to Figure 1, a solid heated block of aluminum for example is placed in the cylinder 10 to the left of the die assembly. Under tremendous pressure, this metal is forced into the throat 5 of the mandrel die member 3. It flows or extrudes along the passageway through the die, and the mass of flowing metal is split by the support 7 for the mandrel 6 like a river flowing along each side of an island. At the right-hand end of the die, the flowing metal strikes the face of the female die 1, and under continued pressure fills "the larger diameter cylindrical opening 4". The metal rebonds itself in this chamber 4 forwardly of the supporting web 7 for the mandrel, making a complete seamless ring, just as the waters at the end of the island merge again into a common mass. With continued pressure, metal forming the ring is then forced to flow through the opening 2 in the female die around the tip of the mandrel, so that the metal emerges in the form

of a seamless tube whose internal diameter corresponds to that of the mandrel 9, and the external diameter of the tube corresponds to the diameter of the opening 2.

The assembly therefore comprises the female die 1, with the cylindrical opening 2, and the mandrel die body 3 having a larger diameter cylindrical opening 4 back of the female die with the mandrel die 3 itself abutting directly against the female die. The mandrel 6 is made integral with the mandrel body 3 through the connecting web 7, and except where the web 7 is located, there is clearance for the flow of metal through the die. The web 7 which supports the mandrel 6 is concaved at its forward end so that the cylindrical chamber 4 completely surrounds the mandrel.

The Dow port hole die, instead of having one supporting web 7 to integrally connect the mandrel with the side wall of the mandrel body, has six such webs, so that the passageway through the die is subdivided into six openings concentrically arranged about the mandrel. In lieu of having a flare 5 at the entrance end of the die for directing the metal inwardly as it slides forwardly through the die, the port hole die has the passageway constituted of this series of holes and webs further out from the center than Skinner, and provides inclined surfaces at 5 that direct the metal radially inwardly into the chamber 4. The assembly includes, however, the female die 1 with the cylindrical opening 2 against which the mandrel body 3 sets or bears. There is an annular cylindrical chamber 4 of larger diameter than the opening through the female die, and the mandrel 6 is integrally attached to the body 3 by the webs 7 and 7*a*.

In the Dow spider die, the body 3 has four deep grooves cut in its surface so that the solid body of metal is in the form of a four-armed spider, and these four grooves 5 obviously flare outwardly. At their right-hand ends, the four grooves open into a continuously cylindrical chamber 4, which is of larger diameter than the opening 2 in the female die 1. Here again the mandrel is supported by four webs 7 instead of one as in Skinner, and the flare 5 is provided in a different manner through the grooves between the spider arms widening out to meet the full diameter of the cylinder 10.

The District Court's Findings.

In its opinion the District Court (R. 522) said:

> "We consider first the question of infringement since Defendant admits that there is some similarity between its dies and that of Plaintiffs. It insists however that there is no infringement, pointing out among other things that there is only a single supporting arm or web in the Skinner patent, while Dow has six in its port hole and four in its spider die. It contends further that this is important because Plaintiffs' claims are limited."

The Court then stated (page 523) that he did not consider the differences very material, and said:

> "Defendant's own witnesses agree that it makes absolutely no difference in operation whether you have one web or four webs. The only question is are they sufficiently rigid and strong, and when asked whether it was a question of 'getting strength' Defendant's witness Mr. Brush said 'No, it is a matter of choice.' "

Continuing, the District Court said:

"Let us further analyze the Dow dies with the four and six radial connections and we find that this is the only difference. They do not follow the Lepan funnel-like or conical openings. They follow Skinner. The ends of the webs of the Dow spider die and the ends of the Dow port hole die abut against the female die as in Skinner. There is a cylindrical opening which is concentric with the opening in the female die and is of larger diameter than the female die as in Skinner. The opening forming the mixing chamber flares outwardly in the spider die through the V-shaped grooves in the periphery of the die to register with the walls of the plunger cylinder as in Skinner, and in the port hole die the opening is similarly flared to communicate with the port holes. The extruded metal in both of Defendant's dies slides lengthwise and is also guided radially down through the mixing chamber as in Skinner. Taking element for element, although the appearance of the structure is different, the parts of the Dow spider die are as defined in the Skinner die. Both Dow dies operate the same as the Skinner die to produce the same results and differ from Hanson in the same way that Skinner differs."

On page 524 the Court said:

"We find that the Dow dies are only immaterial variants of Skinner and that there has been an infringement. A patentee is not limited to the specific embodiment of the invention which is shown in his patent, and the force and effect of the patent is not curtailed by minor subordinate differences."

And at page 525 he stated:

> "As to the Defendant's contention that Skinner is limited by its claims, we cite the well recognized rule that an amended claim is entitled to cover equivalents so long as the amended claim is not thereby expanded to avoid express limitations inserted to secure the patent."

The Circuit Court of Appeals Found Nothing Clearly Erroneous in the District Court's Findings.

The Circuit Court of Appeals has not found these findings of fact to be clearly erroneous. The Circuit Court of Appeals has simply ignored the findings of the District Court. Speaking of the limitations in Skinner's claims it said (R. 557):

> "These limitations compel the Court to limit the invention to the forms and shapes therein defined. There the claims of a patent define an element in terms of form, location, or function, thereby creating an express limitation and where that limitation pertains to the inventive step, other forms may not be treated as equivalents. *D'Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 259 Fed. 236 (C.A. 6); *Crampton Mfg. Co. v. Crampton*, 153 Fed. (2d) 543 (C.A. 6), cert. denied, 328 U.S. 840; *Midland Steel Products Co. v. Clark Equipment Co.*, 174 Fed. (2d) 541 (C.A. 6)."

If the foregoing is a correct statement of the law, and it finds support only in Sixth Circuit decisions, no patentee who has made an important, though limited improvement, can ever prevail unless there has been a slavish reproduction of the exact thing shown in the patent. If that rule is a proper rule, a Trial Court should

exclude evidence in support of the doctrine of equivalents in the case of restricted patents. Why have the District Judge make findings if they are to be brushed aside, as here?

The rule is arbitrary because it is a generalization that completely discounts the facts. It attempts to substitute a formula and exclude evidence.

Whereas the District Court found that although the Dow dies did not have a flare exactly as defined by Skinner, the accused dies do, by their construction, provide the equivalent of a flare in that the metal is caused, in both cases, to move inwardly toward the center, as well as to flow longitudinally through the die, the Circuit Court did not say that this holding was clearly erroneous. It simply said that the accused dies did not have a flare at the entrance end of the throat, and therefore there is no infringement. At no place has the Circuit Court found that the District Court decided the case contrary to the weight of evidence, or in the absence of adequate evidence. It has chosen to take an arbitrary rule, substitute its own findings, and on that basis set aside the judgment of the District Court.

The Decision of the Circuit Court of Appeals Is Contrary to the Applicable Decisions of This Court.

In *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U. S. 605 at page 609 this Court said:

> "Equivalence in the patent law is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose in every respect."

The opinion of the Circuit Court of Appeals does make the question of equivalence "a prisoner of formula". In fact it even goes further and denies protection to anything which does not adhere strictly to the exact language of the claim.

In the *Linde* case this Court also held (page 609):

> "A finding of equivalence is a determination of fact. Proof can be made in any form: Through testimony of experts or others versed in technology. By documents including texts and treatises; and of course by the disclosures of the prior art. * * * It is to be decided by the Trial Court and that Court's decision under general principles of appellate review, should not be disturbed unless clearly erroneous."

In the instant case it was of course recognized before trial by the defense of non-infringement, that the question of equivalence would be a focal point in the case. Demonstrations were made in the Court Room using oleomargarine as a substitute for aluminum, and with dies formed of transparent plastic, so that the Court could witness and compare the different dies involved. The Defendant had an expert, Mr. Alanson P. Brush, of wide renown, and the Plaintiffs' expert, Mr. Rayborn, had a wide practical experience in the field of hollow extrusion. The quotations from the District Court's findings show that he gave careful consideration to the evidence in reaching the conclusion that there had been infringement. As we have shown, the Court of Appeals simply bypassed all of this, and without commenting upon it, has denied infringement on the basis of the literal (and we believe somewhat inaccurate) application of the claim language to the Defendant's dies.

In so doing, the Circuit Court of Appeals has violated Rule 52(a) of the Federal Rules of Civil Procedure which provides in part:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the Trial Court to judge the credibility of the witnesses."

Not only has the Sixth Circuit Court of Appeals deprived the Petitioners of the benefit of their evidence and the benefit of the above-quoted part of Rule 52, but has decided the case contrary to the rules established by this Court in *Graver Tank & Manufacturing Co. v. Linde, supra.*

Furthermore the decision of the Sixth Circuit Court of Appeals, in addition to being contrary to the decision in the *Linde* case, is also contrary to other decisions of this Court preceding the *Linde* case. For example in *Hubbell v. U. S.*, 179 U.S. 77, p. 80, this Court recognized that the claim, even though rejected and thereafter amended, is entitled to fair construction, although it cannot be revived to the scope of the original claim. As pointed out in the *Linde* case, the doctrine of equivalence has been recognized as a part of the fundamental patent law for more than one hundred years.

The Decision of the Sixth Circuit Court of Appeals Appears to Be in Conflict With the Applicable Decisions of Other Circuits.

In attempting to establish a formula restricting the doctrine of equivalents, the Sixth Circuit Court of Appeals has established a rule which is peculiar to that Circuit and which is at variance with the applicable decisions of other Circuits.

In *Claude Neon Lights, Inc. v. E. Machlett & Son et al.,* (C.C.A. 2 1929) 36 F. 2d 574, Justice Learned Hand discussed the doctrine of equivalence extensively and concluded (page 576)

> "It is obviously impossible to set any theoretic limits to such a doctrine, which indeed its origin forbids, since it is in misericordiam to relieve those who have failed to express their complete meaning. * * * Each case is inevitably a matter of degree, as so often happens, and other decisions have little or no value."

Thus it appears that while the Sixth Circuit Court of Appeals approached this case on the basis of an absolute formula enunciated in other cases under different circumstances, the rule in the Second Circuit is that each case must be separately considered and that no general formula is applicable.

The same conclusion has been expressed in the Fourth Circuit Court of Appeals, as for example in *Saco-Lowell Shops et al. v. Reynolds,* (C.C.A. 4 1944) 141 F. 2d 587, in which it was stated (page 589):

> "The questions involved in the appeal are very largely questions of fact and the learned trial judge has given them thorough consideration, hearing

testimony with regard thereto for two weeks or more, witnessing the operation of the machines in controversy and finding the facts in detail in 49 separately numbered findings. These findings are binding upon us except to the extent that we are prepared to hold that they are clearly wrong, Rules of Civil Procedure rule 52, 28 U.S.C.A. following section 723c; * * *"

The court discussed several authorities dealing with the question of infringement and cited with approval the foregoing opinion of the Second Circuit Court of Appeals.

Also in *Frick Co. v. Lindsay,* (C.C.A. 4 1928) 27 F. 2d 59, the court held that even where the invention was for an improvement, the patent was not to be denied the application of the doctrine of equivalents. The court said (page 62):

"While the patent of complaint is not a basic or pioneer patent, this does not mean that it is not entitled to invoke the docrine of equivalents. The range of equivalents, it is true, depends upon the extent and nature of the invention, and if the invention is broad and primary in character, the range of equivalents will be correspondingly broad; but, where the patent is for a mere improvement, a narrower range of equivalents will be applied."

It has likewise been held in the Eighth Circuit Court of Appeals that even improvement patents are entitled to an application of the doctrine of equivalents. For example, in *G. H. Packwood Mfg. Co. v. St. Louis Janitor Supply Co.,* (C.C.A. 8 1940) 115 F. 2d 958, it said (page 963):

"It is also to be remembered that the doctrine of equivalents is applied to other than primary or

generic patents and that, while the range of equivalents depends upon the extent and nature of the invention, even a nongeneric or specific patent is entitled to some range of equivalents. 'Any patent, however, has some range of equivalents, unless form is made the indispensable thing.' "

The court, at page 963, then cited *Frick Co. v. Lindsay, supra,* as well as its earlier decision in *Freeman v. Altvater,* 66 F. 2d 506.

Substantially the same rule is announced by the Seventh Circuit Court of Appeals in *United States Ozone Co. v. United States Ozone Co. of America* (C.C.A. 7 1933), 62 F. 2d 881, page 890.

The action of the Sixth Circuit Court of Appeals in the instant case is, therefore, not only at apparent variance with the rule established by the United States Supreme Court and at variance with some of its own decisions, but is at apparent variance with decisions of other Circuits which are to the effect that even where the patent is of a limited character, evidence of equivalents should be considered. It follows that if evidence of equivalents should be considered, the trial court's findings should not be set aside unless clearly erroneous.

The questions raised by this Petition are important because of the pendency of the other cases referred to in the Petition involving infringement of the same patent by structures more or less generally resembling the Defendant's structures involved in this case, and the disposition of this case by this Court would go far toward resolving the construction to be given the Skinner patent in the other litigation. The questions raised here are

likewise of public importance because they involve the validity of a rule or formula established in the Sixth Circuit Court of Appeals, contrary to many of its own decisions,* attempting to lay down in advance an absolute formula against evidence supporting a showing of equivalence. If the Sixth Circuit Court of Appeals' rule above quoted in this brief stands unchallenged, a District Court in the future may safely exclude evidence of equivalence once it has determined that the patent is for an improvement, as against a so-called basic concept. Clearly if the evidence of equivalence presented to the District Court can be arbitrarily ignored and set aside, and the District Court's findings not followed, even though there is no showing of error, the presentation of such evidence becomes futile and the District Courts themselves might well recognize this fact and exclude such evidence.

The questions raised by this Petition are, we submit, of far-reaching public importance, especially since the Court decided them after the case of *Graver v. Linde,* and notwithstanding that this case was urged as presenting the applicable law in the Sixth Circuit Court of Appeals both on the original appeal and on the Petition for Rehearing.

---

* In the case of D'Arcy Spring Co. v. Marshall Ventilated Mattress Co. (C.C.A. 6) 259 Fed. 236, cited by the Sixth Circuit Court of Appeals in the instant case as supporting the rule above set forth, the Court recognized that even where a claim was limited, the limitations could be satisfied by a showing of equivalence. This is denied in the instant case.

Conclusion.

It is respectfully submitted that Certiorari should be granted in the light of the refusal of the Circuit Court to be bound by the fact findings of the District Court, especially in view of the other suits now being prosecuted by Petitioners in the Sixth Circuit and elsewhere involving the same patent.

CHRISTY, PARMELEE & STRICKLAND

WILLIAM H. PARMELEE
1621 Farmers Bank Building
Pittsburgh 22, Pennsylvania

F. NORMAN HIGGS
420 Bay City Bank Building
Bay City, Michigan

Counsel for Petitioners

LEO T. WOLFORD
501 S. Second St.
Louisville, Kentucky

FRANCIS R. HARBISON
1017 Park Building
Pittsburgh 22, Pennsylvania

Of Counsel

August 21, 1952

INDEX.

Report of Opinions Delivered Below ---- 1

The Petition Is Without Merit ---- 1

The Court of Appeals Properly Reversed the District Court ---- 3

The "Arbitrary Rule" Is Well Established Law ---- 7

The Facts in the Case at Bar ---- 15

The Prosecution of Skinner's Application ---- 16

The Disclosure of the French Lepan Patent ---- 17

Skinner's Effort to Avoid the French Lepan Patent 18

The Accused Dies Do Not Infringe ---- 19

Conclusion ---- 22

TABLE OF CASES.

Exhibit Supply Co. v. Ace Patents Corporation, 315 U. S. 126 (1942) ---- 7

Frick v. Lindsay (C. C. A. 4, 1928), 27 F. 2d 59 ---- 14

Graver Tank & Manufacturing Co., et al. v. Linde Air Products, 339 U. S. 605 ---- 2, 6, 7, 9, 13

Hubbell v. United States, 179 U. S. 77 (1900) ---- 11

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429 (1926) ---- 10

Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274 (1877) ---- 12

Morley Sewing Machine Co. v. Lancaster, 129 U. S. 263 (1889) ---- 12

Packwood Mfg. Co. v. St. Louis Janitor Supply Co. (C. C. A. 8, 1940), 115 F. (2d) 958 ---- 13

Reynolds Metal Co. v. Skinner, et al., 166 Fed. (2d) 66 ---------- 3, 4, 5

Saco-Lowell Shops, et al. v. Reynolds (C. C. A. 4, 1944), 141 F. 2d 587 ---------- 14

Sanitary Refrigeration Co. v. Winters, 280 U. S. 30 (1929) ---------- 10

Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211 (1940) ---------- 10

United States Ozone Co. v. United States Ozone Co. of America (C. C. A. 7, 1933), 62 F. (2d) 881 ---- 14

Weber Electric Co. v. Freeman Electric Company, 256 U. S. 668 (1921) ---------- 11

Winans v. Denmead, 15 How. 330 (1853) ---------- 13

In the Supreme Court of the United States

OCTOBER TERM, 1952.

No. 288.

CHAME D. SKINNER and LEO C. BRADLEY,
Petitioners,

v.

THE DOW CHEMICAL COMPANY,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Respondent, The Dow Chemical Company, opposes the Petition for Certiorari.

REPORT OF OPINIONS DELIVERED BELOW.

The District Court's original and supplemental opinions are reported at 90 Fed. Supp. 877 (R. 519), and 93 Fed. Supp. 805 (R. 538). The opinion of the Court of Appeals for the Sixth Circuit, reversing the District Court, is reported at 197 Fed. (2d) 807 (R. 552).

THE PETITION IS WITHOUT MERIT.

Respondent asserts that the petition is without merit. Contrary to Petitioners' statement (Pet. p. 5), the case is not of public importance. The patent in suit expired over three years ago. The Court of Appeals made no ruling as to validity, expressly stating that by not doing so, the pub-

lic interest was not subserved under the circumstances (R. 560). It reversed on the issue of infringement, which is usually a *private* issue between the owner of a patent and the specific defendant who is making, using or selling the accused device.

Petitioners' assertion that the Court of Appeals adopted "an arbitrary formula" which is in conflict with the decisions of this Court and other Circuits (Pet. p. 5) is a complete reversal of their position in their "Petition for Rehearing" (R. 563) where they admitted that:

> *"The opinion of the Court reaches the conclusion of non-infringement on the correct legal principle that limitations introduced into patent claims by the patentee to secure the grant of the patent cannot be disregarded in the subsequent assertion on infringement** but on the erroneous conclusion that the Dow porthole and spider dies do not *in fact* embody the substance *of the claims as so restricted."*

Thus, in their Petition for Rehearing, Petitioners agreed with the Court in regard to the law it applied but urged that the accused devices were infringements even when the claims were restricted.

Contrary to Petitioners' *present assertion* (Pet. p. 5) there is no conflict between the decision of the Court of Appeals and the decisions of this Court.

The two questions alleged to be "raised by the case" (Pet. p. 6) are not genuine, because they are founded upon false premises.

The "Reasons Relied Upon For Allowance of The Writ" (Pet. p. 6) are fictitious because neither the decision of this Court in *Graver Tank & Manufacturing Co., et al. v. Linde Air Products,* 339 U. S. 605 nor *Rule 52(a)*

---

* Emphasis in all quotations is Respondent's unless otherwise noted.

Federal Rules of Civil Procedure are applicable to the case at bar.

THE COURT OF APPEALS PROPERLY REVERSED THE DISTRICT COURT.

Except to state that the patent in suit (R. 405) is directed to dies to be used in the extrusion of hollow shapes from solid metal billets, Respondent will not discuss the specific facts at this time, but will first discuss the legal reasons why the Court of Appeals properly reversed the District Court.

The trial judge, in his opinion, first stated:

> "The patent involved in this suit was discussed by the Sixth Circuit Court of Appeals in Reynolds Metal Co. v. Skinner, 166 F. 2d 66. *While the issues were not the same, there is much in Judge Allen's opinion that illuminates the questions presented by this case and indicates that the court had under observance many of the points that are of moment herein.*" (R. 519.)

Later in discussing the question of infringement, the District Judge said:

> "In this court's opinion the Dow dies either purposely or by chance result in a circumvention of the Skinner patent *and as Judge Allen said in Reynolds Metal Co. v. Skinner, supra,*
>
> '* * * the various Skinner and Bradley patents open up a new field, that of the extrusion of aluminum products, and are entitled to a liberal construction as to equivalents.' " (R. 523.)

It is obvious that the trial court relied heavily on the decision of the Court of Appeals in the *Reynolds* case.

The trial judge did realize that the claims of the patent in suit were limited by amendment to specific forms and shapes to avoid the prior art, but apparently felt that

the *Reynolds* case required him to construe the claims broadly, for he said:

> "We find that the Dow dies are only immaterial variants of Skinner and that there has been an infringement. A patentee is not limited to the specific embodiment of the invention which is shown in his patent and the force and effect of the patent is not curtailed by minor subordinate differences." (R. 524.)

The trial judge in a further effort to justify a broad construction of the claims, said:

> "As to defendant's contention that Skinner is limited by its claim, we cite the well recognized rule that an amended claim is entitled to cover equivalents *so long as the amended claim is not thereby expanded to avoid the express limitations inserted to secure the patent.*" (R. 525.)

The Court of Appeals reversed the trial Court, because it had fallen into *two errors of law.*

The Court of Appeals stated:

> "We think the conclusion of the District Court was erroneous for two reasons: (1) in making this decision it relied upon our decision in Reynolds Metals Co. v. Skinner, 166 Fed. (2d) 66, cert. denied 334 U. S. 858; and (2) it ignored the law applicable to construction of patents in which the inventor voluntarily limits his claims." (R. 555.)

The above quoted excerpts from both opinions have been emphasized for Petitioners failed to tell this Court of the two errors of law which the Court of Appeals found, were made by the District Court. Petitioners have simply asserted that the Court of Appeals "reversed the District Court on the finding of equivalence," inferring that the reversal was based entirely on an issue of fact (Pet. p. 2). Then, on that false premise it poses the first question "may

the Circuit Court, in the absence of any clear showing of error, set aside those findings?" (Pet. p. 6).

It is obvious that the Court of Appeals reversed the District Court because of two errors of law. When those errors of law were corrected, then the foundation upon which the District Court supported its conclusions collapsed, and they had to be corrected also. Hence, it is obvious that Rule 52(a) of the Rules of Civil Procedure has no applicability in this matter.

Petitioners do not even discuss the first error of law which the District Court committed and which the Court of Appeals corrected. Nor do Petitioners advise this Court whether or not the first error is fatal to their case, regardless of what happens to their Petition.

The first error of the District Court resided in its reliance on the decision in the case of *Reynolds Metal Co. v. Skinner, et al.*, 166 Fed. (2d) 66. That case involved a patent assignment agreement and the contract covered, not only the patent in suit, but two other patents and many unpatentable devices. The issue was whether or not Reynolds was using any of the assigned devices. The Court of Appeals for the Sixth Circuit specifically stated that this was not an infringement suit and that the rules of law relating to the validity and infringement of a patent were not involved (p. 73). The Court further held that the scope of the contract was the issue involved and as between assignors and assignee, a liberal interpretation of the rule of equivalents should be invoked (p. 73).

The District Court in the case at bar erroneously assumed that the Court in the *Reynolds* case had held that the claims of the patents should be liberally construed under the rules of equivalents even in an infringement suit, although the Court of Appeals expressly warned against such an interpretation.

The petition here involves only the second error of law which the Court of Appeals corrected.

Petitioners, in their argument, assert that the Court of Appeals in reversing the District Court has applied "an arbitrary rule" of law (Pet. p. 6) "which is peculiar to the Sixth Circuit" (Pet. p. 3), which is "in conflict with the weight of authority" (Pet. p. 6), which is "not in accordance with the applicable decision of this Court as most recently stated in *Graver Tank & Manufacturing Co., et al. v. Linde Air Products,* 339 U. S. 605" (Pet. p. 6) and which is "contrary to the provisions of Rule 52(a) Federal Rules of Civil Procedure" (Pet. p. 6).

Respondent alleges that every statement of Petitioner, just above quoted, is spurious. Petitioners, when quoting the alleged "arbitrary rule" (Pet. p. 2) from the opinion of the Court of Appeals omit from the quotation, the very premise upon which the rule is founded. The Court of Appeals in discussing the second error of the District Court stated:

> "On the second point the Skinner file-wrapper history reveals that the Patent Office rejected Skinner's original claims upon the French patent, Lepan 8282, or upon the French patent in view of certain other patents cited. Skinner then canceled his original first claim which was drafted in general terms and amended his other claims in order to avoid reading upon the structure of Lepan." (R. 556.)

The Court then set out in detail the similarities between Lepan and Skinner as pointed out by Skinner in his amendment (R. 556). The Court thereafter discussed the various "form" limitations included in the patented claims and then stated:

> "These limitations compel the court to limit the invention to the forms and shapes therein defined. Where

> the claims of a patent define an element in terms of form, location, or function, thereby creating an express limitation and where that limitation pertains to the inventive step, other forms may not be treated as equivalents. *D'Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 259 Fed. 236 (C. A. 6); *Crampton Mfg. Co. v. Crampton*, 153 Fed. (2d) 543 (C. A. 6), cert. denied, 328 U. S. 840; *Midland Steel Products Co. v. Clark Equipment Co.*, 174 Fed. (2d) 541 (C. A. 6)." (R. 557.)

The Court even then, did not ignore the rule as to equivalents, for, immediately after the above quotation, it stated:

> "Skinner's die patent herein involved was for an improvement only, and hence must be narrowly construed as to equivalents." (R. 557.)

THE "ARBITRARY RULE" IS WELL ESTABLISHED LAW.

Contrary to Petitioners' assertions the "arbitrary rule" invoked by the Court of Appeals is a rule that is an established part of this Country's patent laws. This Court has applied this "arbitrary rule" in so many cases that one questions the sincerity of the Petition.

As stated above in their "Motion for Rehearing" before the Court of Appeals, Petitioners admitted that the Court's legal principles were correct (R. 563). But here, they tell this Court it is an arbitrary rule not applied by any other Court.

The opinion of this Court in the case of *Exhibit Supply Co. v. Ace Patents Corporation*, 315 U. S. 126 (1942) applies the "arbitrary rule" invoked by the Court of Appeals and points up the exact reason why the decision in the *Graver Tank* case is not applicable. In the *Exhibit Supply* case the patent related to a pin ball game and had to do specifically with the mounting of the electrical con-

ductor means on the table. Some of the claims as first drafted provided for conductor means *"carried by the table."* These claims were rejected by the Examiner and they were then amended to read conductor means *"embedded in the table."* Respondent admitted that the accused devices did not have their conductor means embedded in the table. Petitioner did not seriously urge that the accused devices were not mechanical equivalents, but did urge that the doctrine of equivalents should be discarded.

This Court in holding that some of the accused devices did not infringe said:

> "Whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without a restrictive amendment, *it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment.*
>
> Assuming that the patentee would have been entitled to equivalents embracing the accused devices had he originally claimed a 'conductor means embedded in the table,' a very different issue is presented when the applicant in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one 'carried by the table.' Had Claim 7 been allowed in its original form, it would have read upon all the accused devices, since in all the conductor means complementary to the coil spring are 'carried by the table.' By striking that phrase from the claim and substituting for it 'embedded in the table,' the applicant restricted his claim to those combinations in which the conductor means, though carried on the table, is also embedded in it. By the amendment, he recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference. *Hubbell v.*

United States, 179 U. S. 77, 83; *Weber Electric Co. v. Freeman Electric Co.,* 256 U. S. 668, 677-78; *I. T. S. Rubber Co. v. Essex Rubber Co.,* 272 U. S. 429, 440, 444; *Smith v. Magic City Kennel Club,* 282 U. S. 784, 789; *Schriber Co. v. Cleveland Trust Co.,* 311 U. S. 211; cf. in case of disclaimer *Altoona Theatres v. Tri-Ergon Corp.,* 294 U. S. 477, 492, 493. The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference it must be strictly construed against him. *Smith v. Magic City Kennel Club, supra,* 790; *Shepard v. Carrigan,* 116 U. S. 593, 598; *Goodyear Dental Vulcanite Co. v. Davis,* 102 U. S. 222, 228. As the question is one of construction of the claim, it is immaterial whether the examiner was right or wrong in rejecting the claim as filed. *Hubbell v. United States, supra,* 83; *I. T. S. Rubber Co. v. Essex Rubber Co., supra,* 443. It follows that what the patentee, by a strict construction of the claim, has disclaimed—conductors which are carried by the table but not embedded in it—cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed." (pp. 136, 137.)

This is exactly the rule that was applied by the Court of Appeals in reversing the District Court.

The opinion quoted from above demonstrates why the rule in the *Graver Tank* case is not applicable to the case at bar. The claims in the *Graver Tank* case were allowed "without a restrictive amendment" and the doctrine of equivalents was applicable to secure the inventor the full benefits of his claims. In the case at bar, the claims were allowed only after they had been restrictively amended to shape and form. The Court of Appeals held in the case at bar, as did this Court in the *Exhibit Supply* case, that as the claims had been restrictively amended, the doctrine of

equivalents could not be invoked to regain what the inventor had disclaimed.

This "arbitrary rule" has been invoked by this Court in many cases over a long period of time.

In *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211 (1940), the rule was stated in these words:

> "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. *Shepard v. Carrigan*, 116 U. S. 593; *Sutter v. Robinson*, 119 U. S. 530; *Roemer v. Peddie*, 132 U. S. 313; *Phoenix Caster Co. v. Spiegel*, 133 U. S. 360; *Hubbell v. United States*, 179 U. S. 77; *Weber Electric Co. v. E. H. Freeman Electric Co.*, 256 U. S. 668; *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, 443. The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. *Smith v. Magic City Club*, 282 U. S. 784, 790; *Weber Electric Co. v. E. H. Freeman Electric Co., supra*, 677, 678; *I. T. S. Rubber Co. v. Essex Rubber Co., supra*, 444." (pp. 220, 221.)

In *Sanitary Refrigeration Co. v. Winters*, 280 U. S. 30 (1929) the "form" limitation rule was recognized when discussing infringement:

> "*Except where form is of the essence of the invention, it has little weight in the decision of such an issue;*" (p. 42).

In *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429 (1926), the Court applied the "arbitrary rule" in these words:

> "It results that as the claims in suit were limited by the proceedings in the Patent Office to the specific

form of a three-point-contact lift, they are not infringed by the heels made by the Essex Company, which are not three-point-contact lifts, their upper side edges having no vertical curve and lying entirely in the same horizontal plane as the rear edge and breast corners. Nor can they be held to be infringements even if we assume that, as asserted, they function in the same manner as three-point-contact lifts, and would infringe, as was conceded in the District Court, if the claims were not restricted by the limiting clause and were entitled to a construction warranting a wide range of equivalents. *By the limitation of the claims in the Patent Office proceeding to the three-point-contact lift the patentee made this precise form a material element, and having thus narrowed the claims, cannot,* as was said in the Weber Electric Company case, *now enlarge their scope by a resort to the doctrine of equivalents.* This would render nugatory the specific limitation." (pp. 444, 445.)

In *Weber Electric Co. v. Freeman Electric Company,* 256 U. S. 668 (1921), the Court also applied the rule:

"Having thus narrowed his claim against rotary movement in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments, which amount to a disclaimer of rotation as an operative feature of his device. *Shepard v. Carrigan,* 116 U. S. 593, 598; *Hubbell v. United States,* 179 U. S. 77, 80." (pp. 677, 678.)

Even in the case of *Hubbell v. United States,* 179 U. S. 77 (1900), cited by Petitioners as being contrary also to the rule applied by the Sixth Circuit (Pet. p. 15), this Court recognized the "arbitrary rule":

"An examination of the history of the appellant's claim, as disclosed in the file wrapper and contents, shows that in order to get his patent he was compelled

to accept one with a narrower claim than that contained in his original application; and it is well settled that the claim as allowed must be read and interpreted with reference to the rejected claim and to the prior state of the art, and cannot be so construed as to cover either what was rejected by the Patent Office or disclosed by prior devices. *Leggett v. Avery,* 101 U. S. 256; *Shepard v. Carrigan,* 116 U. S. 593; *Knapp v. Morss,* 150 U. S. 221, 227." (p. 80.)

In *Morley Sewing Machine Co. v. Lancaster,* 129 U. S. 263 (1889), this Court had this to say:

"But if the invention claimed be itself but an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by use of a different form or combination, performing the same functions. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first." (p. 274.)

In *Keystone Bridge Co. v. Phoenix Iron Co.,* 95 U. S. 274 (1877), this is found in the opinion:

"We do not think we ought to disturb the decree of the Circuit Court in this case. We regard the construction of the claims in question insisted upon by the appellee as substantially correct. Those claims are the first in the patent of 1862, and the third in that of 1865. It is manifest that, in the former, the form of the chords is deemed material, or, at least, it is made so by the terms of the specification and claim. They are flat bars placed on edge so as to sustain superincumbent weight, as well as perform the office of tension braces." (p. 275.)

* * * * *

"Words cannot show more plainly that the claim of the inventor does not extend to any other eyebars or

chords than such as are made wide and thin, and applied on edge. As those constructed by the defendant are cylindrical in form, only flattened at the eye for insertion between the ribs or projections of the posts, it is plain that no infringement of this claim of the patent has been committed." (p. 276.)

Even in the case of *Winans v. Denmead,* 15 How. 330 (1853), in which the doctrine of equivalents originated (see the *Graver Tank* case, 339 U. S. 605, 608), it was recognized that at times the alleged "arbitrary rule" should be applied to a patent. This Court in that case said:

"Undoubtedly there may be cases in which the letters-patent do include only the particular form described and claimed." (p. 343.)

In the *Winans* case, although the claim designated a particular form of car body, yet the Court held the claims were not limited to this particular form because form was not the essence of the invention. Thereupon, the Court applied the doctrine of equivalents.

In the case at bar the claims were necessarily limited to form to distinguish them from the prior art and form was therefore the essence of the invention. Because of that fact the Court of Appeals applied the allegedly "arbitrary rule."

Even the authorities cited in support of the petition recognize the "arbitrary rule" as applied by the Sixth Circuit.

Thus, in *G. H. Packwood Mfg. Co. v. St. Louis Janitor Supply Co.* (C. C. A. 8, 1940), 115 F. (2d) 958, the Court said:

"Any patent, however has some range of equivalents, *unless form is made the indispensable thing.*" (Pet. pp. 17, 18.)

In *Saco-Lowell Shops, et al. v. Reynolds* (C. C. A. 4, 1944), 141 F. 2d 587 (Pet. p. 16), that Court recognized the "arbitrary rule" because it quoted from decisions of this Court to the effect that the doctrine of equivalents should be invoked "Except where form is of the essence of the invention," (p. 593).

In *Frick v. Lindsay* (C. C. A. 4, 1928), 27 F. 2d 59 (Pet. p. 17), Judge Parker for that Court at page 62 again recognized the "arbitrary rule" applied by the Sixth Circuit.

United States Ozone Co. v. United States Ozone Co. of America (C. C. A. 7, 1933), 62 F. (2d) 881 (Pet. p. 18), is not inconsistent with the decision of the case at bar, for that Court said:

> "While some means was necessary, *neither its form nor its location was material* to the functioning or to the patentability of the device. *Under these circumstances,* the expedient which the inventor chose to specify in his claims should be given a broad range of equivalency in order to protect the substance of his invention." (p. 890.)

So, it is obvious from a review of many of the cases over the past years that the "arbitrary rule" and the doctrine of equivalents, though superficially inconsistent, are actually consistent—each rule being applied when the proper circumstances for its application arises. That is why the Petition is without merit and should be denied.

THE FACTS IN THE CASE AT BAR.

It having been established that the alleged "arbitrary rule" applied by the Sixth Circuit is a well established rule of patent law, Respondent will now point out why this rule is applicable to the facts of the case at bar.

Skinner's attorney had made a search of the prior art before he filed the application for the patent in suit. He found the Hansons' patent (R. 73). Respondent has consistently asserted that the disclosures of the Hansons' patents (R. 447, 455, 462) justified its use of the accused dies. Regarding the Hansons' patents the Court of Appeals said:

> "The three Hanson patents covered the extrusion of 'lead or tin or any alloy of soft metals.' Operations were conducted under Hanson reissue patent 82 over a century ago. *Tatham v. Lowber,* Fed. Cas. 13764; *LeRoy v. Tatham,* 14 How. 155. In *LeRoy v. Tatham,* 22 How. 132, the reissue patent was held valid and infringed. In the subsequent accounting substantial damages were allowed and the defendants conceded that under the Hanson disclosure they had manufactured almost a million feet of lead pipe. It follows that the Hanson patents were operable.
>
> The accused dies, the Dow spider die and the Dow porthole die, differ markedly in appearance from the Skinner die, and in certain respects resemble Hanson." (R. 554.)

Skinner (R. 405) varied his device from Hansons' basic teachings in several ways. His mandrel holder is a hollow cylindrical body without an entrance face. His mandrel is integral with the *inner wall* of his cylindrical holder. His connection between the mandrel and holder is concaved in the direction of metal flow (See Fig. 6). The entrance of the opening through his mandrel holder flares outwardly to register with the plunger cylinder

for funnelling the metal into the mandrel holder. The entrance end of his mandrel holder abuts against a shoulder provided in the plunger cylinder. Yet, in the broadest claim submitted to the Patent Office, Skinner just included a few of these variations to avoid Hansons.

The Prosecution of Skinner's Application.

The broadest claim Skinner ever asserted (which was later cancelled) is as follows:

> "1. Extruding die mechanism comprising a hollow extrusion die having a major diameter opening, a mandrel die abutting thereagainst *having an opening concentric therewith* and a centrally arranged mandrel extending into the hollow extrusion die *and provided with a lateral holding connection with the side wall of the mandrel die.*" (R. 429.)

Hansons' mandrel holder does not have an opening through it, concentric with the opening of the female die because Hansons, by the use of their spider mandrel holder, provide for four openings each of which is *eccentric* to the female die opening. The Hansons' openings lead into the mixing chamber which is concentric to the female die opening. While Hansons teach that their spider mandrel holder can be made integral with the walls of the mixing chamber, they do not teach that the mandrel can be connected by a lateral attachment *with an inner side wall.* It is obvious, therefore, why the Patent Office did not cite Hansons against Skinner.

Original proposed Claims 2, 3, 4, 5 and 6 were more limited than was original proposed Claim 1 (R. 429-431).

The Examiner, in his first action, rejected all of Skinner's proposed claims. He relied upon the French Lepan patent 8,282 (R. 503) and rejected original Claims 1, 2 and 6 as being fully met (R. 435). He further rejected

original Claims 3, 4 and 5 on the French Lepan patent in view of some of the other general apparatus patents because Lepan disclosed only the die mechanism.

Skinner acquiesced in the Examiner's rejection of his original Claim 1 and cancelled that claim without arguing for it or amending it in any manner whatsoever (R. 436). Original Claims 2, 3, 4, 5 and 6 were not cancelled, but Skinner amended each of those claims to avoid reading on the specific structure of the Lepan French patent (R. 436-7). Skinner also added Claims 7, 8 and 9 which were, of course, at that time drafted to avoid not only Hansons, but also Lepan (R. 437-8). After these amendments were made and original Claim 1 was cancelled, Claims 2 to 9 inclusive were renumbered 1 to 8 and were issued in the Skinner patent (R. 444).

The Disclosure of the French Lepan Patent.

Lepan's patent (R. 503) is directed to the extrusion of metals. Lepan's female die is marked K while the cylindrical mandrel holder is marked C. The mandrel holder has a concentric opening through it, extending from one end to the other as does Skinner. The mandrel holder, like Skinner, has no entrance face. The mandrel A is positioned within this opening of the holder and is laterally connected to the inner side wall of the holder as is Skinner. The mixing chamber around the mandrel and in front of the most constricted part of the female die is marked G. The mandrel holder abuts the female die as does Skinner and at times when Lepan found it desirable he locked the male and female dies together such as by the dowel pin M as shown in Fig. 4, and as described in detail by the witness Brush (R. 169-170). The mandrel holder at its entrance side also abuts against the plunger cylinder.

Skinner's Effort to Avoid the French Lepan Patent.

Skinner realized that he was not entitled to his original proposed Claim 1 because, although limited as it was to avoid the Hansons' patent, yet it was broad enough to read word for word on the French Lepan patent. Skinner amended his remaining claims in details relating to form, location and arrangement so as to distinguish his claims from Lepan's device and the patent was issued with those limitations.

The Court of Appeals not only set forth the similarities between Skinner and Lepan but pointed out how Skinner distinguished his claim from Lepan:

> "In Lepan as in Skinner the mandrel holder is cylindrical and has no entrance face. The mandrel is positioned within the concentric conical opening of the mandrel holder and is laterally connected to the side wall of the holder. The mandrel holder abuts against the female die and Lepan locked the male and female dies together with a dowel pin. The concentric construction which is important in Skinner was thus disclosed in Lepan and the rigid holding of the mandrel was taught in some degree. In his communications with the Patent Office Skinner pointed out that his bearing in the female die was cylindrical while that of Lepan was conical and that his mandrel was strongly attached to the walls of the mandrel holder by the concaved shank portion. He also distinguished from Lepan as to the continuously annular space around the mandrel by spacing it backwardly from the female die while Lepan's continuously annular space is located mainly in the female die. Skinner emphasized these distinctions in the amendments to his claims and in the addition of three new claims. The limitations of form voluntarily imposed by Skinner and appearing in various of his patent claims include the following: a female die 'having a major diameter cylindrical opening,' a mandrel 'connected

laterally with the wall of the mandrel die by concaved surfaces,' a 'longitudinal cylindrical opening' through the mandrel holder, and a mixing chamber which is a 'continuously annular clearance opening.' Also these limitations are emphasized by repetition in substance." (R. 556, 557.)

Immediately following the above quotation, the Court of Appeals invoked the alleged "arbitrary rule." (R. 557.)

The Accused Dies Do Not Infringe.

Certain photographs showing Respondent's dies were offered in evidence. This book of exhibits is evidently not before this Court. However, if this Court will ignore the different shades of cross hatching in the top views of the accused dies on the pull sheet opposite R. 565, these representations might suffice.

The Court of Appeals briefly described the two accused dies as follows:

"In the spider die the mandrel holder is a cruciform from the center of which a fixed mandrel extends. The female die is a flat-faced die with a cylindrical bearing. At its outer edge are arcuate projections which cooperate as abutments with the four arms of the mandrel holder. The mandrel holder has a flat entrance face which causes the plastic metal, when pressed forward by the plunger, to divide and flow through the four V-shaped spaces between the spider arms into the mixing chamber and through the orifice of the female die.

In the Dow porthole die the mandrel holder is a metal cylinder having a flat entrance face in which six holes are symmetrically arranged around the female die. In the center of the exit end of the cylinder an integral mandrel is located having around it an annular recess. The mixing chamber is located within the female die which discloses six channels that regis-

ter with the six holes through the mandrel holder. The female die is positioned within the annular recess formed in the exit end of the mandrel holder." (R. pp. 554-555.)

The Court of Appeals also noted that the Skinner die and the accused dies fall in two different classes in these words:

"Dow asserts that there are two classifications of die, one derived from Hanson, under which the accused dies, the Dow spider die and the Dow porthole die, are made. It describes this class of die as one in which the mandrel holder has an obstructing entrance face through which there are a number of passageways into the mixing chamber 'located eccentrically but arranged symmetrically around the center of the mandrel.' The metal is divided into separate streams and flows through these passageways into the mixing chamber.

The second class of die described by Dow, which Dow says includes the Skinner device, covers dies in which there is a cylindrical mandrel holder without an entrance face but with a single concentric passageway which is partially blocked by the wall support for the mandrel. In this die the metal is not divided into separate streams but is only partly divided by the mandrel support. It is asserted that a die of one class is not equivalent of a die of the other class." (R. 553, 554.)

The Court of Appeals thereafter held that the Skinner die and the accused dies operated differently by stating:

"The accused dies reveal certain features used by Skinner. The mandrel is rigidly fixed and the mandrel die bears against the female die but in each case there is an entrance face which obstructs the flow of the metal and causes the direction and operation of the flow to differ from that of Skinner." (R. 555.)

The Court of Appeals could have spelled out in greater detail the difference in operation of the two classes of dies. As there are several streams of metal flowing through openings symmetrically arranged around the mandrel in the Hansons' and the accused dies, the pressure on all sides of the mandrel is balanced and, so, there is no tendency to push the mandrel out of alignment. In the case of Skinner and Lepan, however, there being only one concentric opening which is partially blocked by the lateral wall support for the mandrel, the flowing metal is not divided into separately opposed streams but is merely cleaved part way through, thereby causing the major portion of the metal to pass over the mandrel on its unsupported side which tends to push the mandrel out of alignment.

The Court of Appeals thereafter discussed each claim in suit and the limitations found therein, which were not included in the accused dies:

> "Claim 1 of the patent provides for a mandrel holder having a larger cylindrical opening concentric with the female die 'flaring outwardly at its other end for registering connection with a plunger cylinder.' This is retained in substance in Claims 4, 5 and 6. This feature is revealed by neither of the accused dies. Claim 3 calls for a lateral connection between the mandrel and the wall of the mandrel die by concaved surfaces. This is repeated in substance in Claims 1, 5 and 6. Neither of the accused dies has this feature. Claim 6 requires a continuously annular clearance opening. The Dow spider die does not reveal this, for its mixing chamber is interrupted by the projections of the spider arms. In the porthole die the mixing chamber, instead of being between the outlet end of the mandrel die and the face of the female die as in Skinner, is wholly within the female die. By his emphasis upon these features Skinner showed that he regarded

them as important and as pertaining to the inventive step. He called witnesses in this case to testify to their importance. Since he considered these elements as part of his invention and since they are not included in the accused dies, infringement is not shown." (R. 557-559.)

It is clear from the above that the facts of the case at bar required the Court of Appeals to reverse the trial court because it had failed to apply the so-called "arbitrary rule" in deciding the issue of infringement.

CONCLUSION.

Respondent respectfully submits that, contrary to Petitioners' assertions, there are no questions of public interest involved and there is no conflict between the law applied by the Court of Appeals and the many decisions of this Court. The Petition for the Writ of Certiorari filed herein is without merit, and should be denied.

Respectfully submitted,

CLARENCE B. ZEWADSKI,
3053 Penobscot Building,
Detroit 26, Michigan,

WILLIAM M. YATES,
The Dow Chemical Company,
Midland, Michigan,
Counsel for Respondent.